

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of
Masayuki TSUCHIYA et al.

Serial No. 09/114,285

Filed: July 13, 1998

For: RESHAPED HUMAN ANTIBODY TO HUMAN INTERLEUKIN-6 RECEPTOR



Group Art Unit: 1642

Examiner: G. Bansal

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(NE)

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LETTER

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Interview Summary dated August 26, 2001¹, Applicants note that the PTO has recognized that the finality of the July 26, 2000 final Office Action will be withdrawn. The Interview Summary and July 26, 2000 final Office Action are attached hereto as Exhibits 1 and 2, respectively. Applicants are awaiting an Office Action responsive to the Amendment dated June 30, 2000 (hereafter "the June 2000 Amendment") and the Amendment after final dated June 20, 2001 (here after "the Amendment After Final"). The June 2000 Amendment and the Amendment After Final are attached hereto as Exhibits 3 and 4, respectively. As indicated in the Interview Summary, the July 26, 2000 final Office Action and the Advisory Action dated August 8, 2001 were erroneous because they did not consider the June 2000 Amendment or the Amendment After Final.

A brief summary of the events leading up to the issuance of the Interview Summary are as follows. The PTO issued a first Office Action on October 13, 1999. Applicants

¹ The Interview Summary states that the date of the interview was August 26, 2001; however, the actual date of the interview was August 23, 2001.

submitted a timely response to the first Office Action on April 13, 2000. Applicants subsequently submitted an Amendment Accompanying Substitute Sequence Listing In Accordance with 37 C.F.R. §§ 1.821-1.825 on June 30, 2000 (the June 2000 Amendment). The PTO issued the improper final Office Action on July 26, 2000 without considering the June 2000 Amendment.

Applicants filed a Notice of Appeal on January 26, 2001. On June 20, 2001, Applicants filed the Amendment After Final. However, an Advisory Action was not mailed until August 8, 2001. During the period between Applicants filing of the Amendment After Final and the USPTO's issuance of the Advisory Action, Applicants' representative contacted the USPTO to inquire as to the status of the application. The PTO informed Applicants' representatives that the delay in responding to the Amendment After Final was because the file had been misplaced at the PTO.

The Examiner refused entry of the Amendment After Final, stating in the Advisory Action that the proposed amendments would raise new issues that would require further consideration and/or search; raise the issue of new matter; and were not deemed to place the application in better form for appeal. Applicants' representatives contacted the Examiner on August 14, 2001 to inform her that the Advisory Action was erroneous. Applicants advised the Examiner that the subject matter would not require further consideration and/or search as the issues were properly addressed in the June 2000 Amendment which was never considered by the PTO. The Examiner informed Applicants' representatives that the June 30, 2000 Amendment was not considered because a copy of this Amendment did not appear in the file. At the Examiner's request, Applicants faxed a copy of the June 2000 Amendment along with a date stamped postcard showing that the PTO had timely received the Amendment. The Examiner

indicated in the August 23, 2001 Interview Summary that “upon review it was discovered that the June 30, 2000 amendment had crossed in the mail with the final office action. Therefore the finality will now [be] withdrawn.”

As there has been no substantive communication from the PTO with respect to the June 2000 Amendment or the Amendment After Final, Applicants respectfully request that the PTO issue a substantive communication in response to the June 2000 Amendment and the Amendment After Final.

If the Examiner has any questions concerning this application, she is requested to contact the undersigned.

Respectfully submitted,

Date August 27, 2001

By Eve L. Frank

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Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.